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In re Application of :
Louise G. Battle et al :
Serial No.: 10/009,583 : PETITION DECISION
Filed: March 19, 2002 :
Attorney Docket No.: 8830-10 :

This is in response to the petition under 37 CFR 1.181, filed June 18, 2004, for withdrawal of abandonment of the above identified application based on filing of a timely reply.

A review of the file history shows that the examiner mailed a Final Office action to applicant on September 24, 2003, setting a three month shortened statutory period for reply. Applicant filed an amendment on December 22, 2003, which resulted in the mailing of an Advisory Action to applicant on February 12, 2004, indicating entry of the amendment, but that the claims remained rejected for specific reasons as set forth in the Final Office action. Applicant filed a second amendment after Final reply further amending the claims on March 11, 2004, with an expectation that the claims would be allowed based on a telephonic interview with the examiner. The examiner mailed an Advisory Action to applicant on April 5, 2004, again indicating entry of the amendment, but that the claims remained rejected for other reasons than stated in the previous Advisory Action. Applicant did not file a Notice of Appeal or RCE papers prior to the expiration of the six month statutory period for reply, but relied on an oral communication as to the allowability of the application. The application became technically abandoned on March 25, 2004, for failure to file a proper reply to a Final Office action. No Notice of Abandonment has been mailed to applicant at this time.


Applicant argues that the second Advisory Action was mailed after the statutory period for a proper reply had expired and that it maintained the rejection of the claims on different grounds than set forth in the Final Office action. Applicant further refers to a telephonic interview on March 2, 2004, with the examiner and the purported results thereof. As the examiner placed no record of the interview in the application file it cannot be ascertained what the substance of the interview was from the examiner's viewpoint. It is apparent that applicant relied on receiving a favorable decision as to patentability based on the interview and took no further steps to preserve the pendency of the application. The examiner, however, again reviewed the claims and prior art and determined that the application was not in condition for allowance and provided reasons to applicant for such decision. Such reasons find some basis in the Final Office action, although not in the same words. Such reasons, however, rise to the level of a new ground of rejection

since the same reference is relied upon but different arguments are presented which were not made in the Final Office action. In retrospect the examiner should have reopened prosecution and prepared a new Office action rather than mail an Advisory Action to applicant.

The petition is **GRANTED**. The application will not be held abandoned in view of applicant's failure to file a proper reply to a Final Office action in view of the examiner's procedural error.

The application will be forwarded to the examiner for preparation of a new Office action not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 703-872-9306.


Bruce M. Kisliuk
Director, Technology Center 1600